



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DK

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/033,662	03/03/98	HU	J 1488.1040001

HM12/0302
STERNE KESSLER GOLDSTEIN & FAX
1100 NEW YORK AVENUE N W
SUITE 600
WASHINGTON DC 20005-3934

EXAMINER

SADUD, C
ART UNIT PAPER NUMBER

1646
DATE MAILED: 03/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/033,662

Applicant(s)
HU et al.

Examiner
Christine Saoud

Group Art Unit
1646



☒ Responsive to communication(s) filed on Dec 30, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 26-65 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 26-29, 33, 38-41, 45, 50, 51, and 57-60 is/are allowed.

☒ Claim(s) 30-32, 34-37, 42-44, 46-49, 52-56, and 61-65 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

DETAILED ACTION

Status of the Claims

1. Prosecution is reopened. Claims 26-65 are pending in the instant application. The indicated allowability of claims 30-32, 34-37, 42-44, 46-49, 52-53, 54-56 and 61-65 is withdrawn in view of the newly discovered reference(s) to Eriksson et al. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 30-32, 34-37, 42-44, 46-49, 52-53, 54-56 and 61-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Eriksson et al. (U.S. Pat. No. 5,928,939).

The instant claims are directed to polypeptides comprising at least 50 contiguous amino acids of SEQ ID NO:2, as well as specific fragments spanning amino acids 69-82 and 46-123 of SEQ ID NO:2, fragments which have angiogenic activity or antigenic activity. The claims are further directed to polypeptides which comprise a heterologous polypeptide, made in a recombinant cell, and pharmaceutical compositions.

Art Unit: 1646

Eriksson et al. teach a polypeptides of SEQ ID NO:11 and 15 which share a contiguous stretch of 119 and 149 identical amino acids, respectively, with the polypeptide of SEQ ID NO:2 of the instant application (see Figure 11 and 15 of Eriksson et al.). These polypeptides clearly anticipate the polypeptides of claims 30-32. Claims 34-35 require antigenic activity, however, the polypeptides of Eriksson et al. would clearly bind an antibody having specificity for the polypeptide of SEQ ID NO:2 of the instant application due to the high degree of sequence identity. Additionally, the polypeptides of Eriksson et al. also possess angiogenic activity, meeting the limitations of claims 36-37. Claims 42-44 and 46-49 require a heterologous peptide, however, Eriksson et al. teach the expression of the polypeptide of SEQ ID NO:11 with a mellitin signal peptide, which is a heterologous peptide from honeybees (see column 15, lines 25-44). The polypeptides of Eriksson et al. are produced recombinantly (see Example 9 beginning in column 14, line 52), meeting the limitations of claims 52-56. Eriksson et al. also teach pharmaceutical compositions in that the polypeptide of SEQ ID NO:11 was used to stimulate cell proliferation, requiring the polypeptide to be in an appropriate pharmaceutical composition (see Example 10 beginning at column 15, line 45), meeting the limitations of claims 61-65. Therefore, the claims are anticipated by Eriksson et al., absent evidence to the contrary.

Allowable Subject Matter

4. Claims 26-29, 33, 38-41, 45, 50-51, and 57-60 are allowed.

Art Unit: 1646

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 1, 2000

CHRISTINE SAOUD
PATENT EXAMINER

Christine Saoud